

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claims 1-20 have been canceled without prejudice or disclaimer. Newly added claims 21-39 are directed to methods for preventing biological adhesion. Support for new claim 21 can be found in the instant specification at least at page 4, paragraph [0007], taken in connection with page 12, paragraph [0036] and pages 35-36, paragraph [0035]. Support for new claims 22-39 can be found at least at pages 4-12 of the specification. Consideration of such method claims in the present application is appropriate in view of the Patent Office's previous consideration of (now canceled) method claim 20.

In the Official Action, claim 10 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite. This rejection is moot in view of the above cancellation of claim 10.

Claims 1-20 stand rejected under 35 U.S.C. §102(a) as being anticipated by International Application No. WO 2004/081055 (*WO '055*). This rejection is moot in view of the above cancellation of claims 1-20. Moreover, it is noted that the present application claims the benefit of priority of Japanese Patent Application No. 2004-072887 filed March 15, 2004. Such foreign priority date is prior to the September 23, 2004 publication date of *WO '055*. Further, Applicants submit that the claims of the present application are supported by the disclosure of the '887 priority application. In this regard, attached for the Examiner's consideration is a verified English translation of the '887 priority application. In view of the perfected foreign priority claim, *WO '055* has been removed from qualifying as §102(a) prior art with respect to the present application.

Claims 1-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by International Application No. WO 00/27886 (*WO '886*). Claims 1-5, 7, 9, 11, 15, 16, 18 and 20 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,630,457 (*Aeschlimann et al.*). Such rejections are moot in view of the above cancellation of claims 1-20. Moreover, Applicants submit that new independent claim 21 is not anticipated by the above applied art for at least the following reasons.

Independent claim 21 is directed to a method for preventing biological adhesion comprising the steps of: providing an adhesion preventive material comprising a crosslinking polysaccharide derivative containing at least one active ester group introduced in a polysaccharide side chain, which is capable of reacting with an active hydrogen-containing group, reacting the adhesion preventive material in the presence of water in a biological site under an alkaline condition, forming a crosslinked material due to covalent binding of the active ester group and the active hydrogen-containing group, wherein the method is effective to prevent biological adhesion in the biological site.

Concerning the alleged anticipation, it is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). For an anticipation to exist, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In the present case, *WO '886* does not disclose a method comprising reacting the adhesion preventive material in the presence of water in a biological site under an alkaline condition, wherein the method is effective to prevent biological adhesion in the biological

site, as recited in claim 21. There is simply no disclosure in *WO '886* of a method that is effective to prevent biological adhesion in the biological site as presently claimed.

Aeschlimann et al also fails to constitute an anticipation of independent claim 21. In such claimed method, the adhesion preventive material is reacted in the presence of water in a biological site under an alkaline condition, wherein the method is effective to prevent biological adhesion in the biological site. *Aeschlimann et al* has no disclosure of such a method. It is noted that Example 9 of *Aeschlimann et al*, which has been cited at page 6 of the Official Action, does not relate to a reaction in the presence of water **in a biological site** under an alkaline condition, as is presently claimed. Nor is there any disclosure in such example of **the prevention of biological adhesion in the biological site**, as is presently claimed.

Accordingly, for at least the above reasons, Applicants submit that *WO '886* and *Aeschlimann et al* fail to constitute an anticipation of claim 21.

Claims 1-5, 11, 12, 15 and 16 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claim 16 of copending Application No. 10/546,256. Claims 1-5 and 11-16 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claim 18 of copending Application No. 10/546,256. Without addressing the propriety of the Examiner's comments in connection with the above rejections, it is noted that such rejections are moot in view of the above amendments, in which the rejected claims have been canceled without prejudice or disclaimer.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

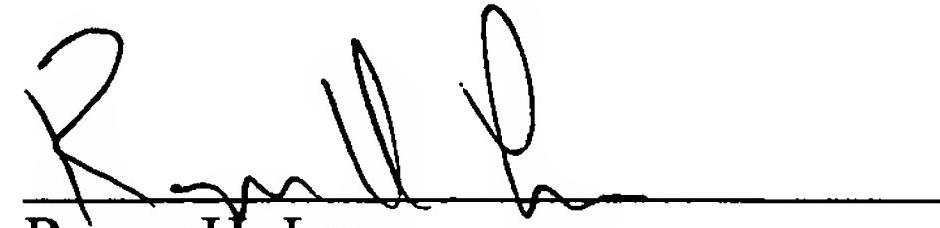
If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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